

REMARKS

This Application has been carefully reviewed in light of the Office Action dated April 29, 2009 (“*Office Action*”). Applicants amend Claims 106, 109, 110, 113-117, and 119. Applicants cancel Claims 111, 118, and 120-125. Applicants respectfully request reconsideration of the pending claims and favorable action in this case.

Applicants’ Summary of Interview

Applicants thank the Examiner for the courtesy and opportunity to conduct the telephone interview on July 21, 2009. During the telephone interview, Applicants and Examiner discussed the rejections of the claims. In particular, Applicants and Examiner discussed the rejections under 35 U.S.C. § 103(a) and proposed amendments. It is Applicants’ understanding that no agreement was reached.

Claim Rejections under 35 U.S.C. § 112

The Examiner rejects Claims 120-125 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Although Applicants believe that all previously pending claims recite statutory subject matter under 35 U.S.C. § 112, to advance prosecution, Applicants cancel Claims 120-125 rendering this rejection moot.

Claim Rejections under 35 U.S.C. § 103

The Examiner rejects Claims 106-125 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,946,386 to Rogers (“*Rogers*”) in view of U.S. Patent No. 6,711,166 to Amir (“*Amir*”). Applicants respectfully traverse this rejection and submit that *Rogers* and *Amir*, whether taken alone or in combination, fail to teach or suggest each and every limitation of the claims.

Consider Applicants’ independent Claim 106 which recites:

A method, comprising:

receiving, by a server located at a customer premises coupled to a local network, an indication from at least one gateway device to initiate a communications session between a dumb terminal coupled to the local network and a remote terminal coupled to an external Internet Protocol (IP) packet switched network, the server comprising a network interface and a controller, the network interface coupled to the local network, the at least one

gateway device coupled to the local network and the external IP packet switched network, the dumb terminal comprising a non-IP telephone;

generating, by the controller, an abstraction of at least one signaling message received from the dumb terminal by interpreting an intent of the at least one signaling message, the abstraction of the at least one signaling message comprising a description of the at least one signaling message based on the interpreted intent of the at least one signaling message;

translating, by the controller, the abstraction of the at least one signaling message; and

transmitting, by the server, the translated abstraction of the at least one signaling message to the at least one gateway device for presentation to the remote terminal, thereby establishing the communications session and facilitating a media stream path without the server between the dumb terminal and the remote terminal.

Among other aspects, the cited references fail to teach or suggest “transmitting, by the server, the translated abstraction of the at least one signaling message to the at least one gateway device for presentation to the remote terminal, thereby establishing the communications session and facilitating a media stream path without the server between the dumb terminal and the remote terminal,” as recited by amended Claim 106. As teaching a previous version of Claim 106, the *Office Action* points to *Amir* and *Rogers*. *Rogers* teaches a call management computer that intercepts and automatically answers each call. *Rogers*, col. 3, lines 34-40. *Amir* discloses a switch that transmits and receives packets on behalf of analog and ISDN telephones. *Amir*, Figures 1 and 2A. Applicants respectfully submit that the call management computer as taught by *Rogers* and the switch taught by *Amir* fail to teach or suggest establishing the communications session and facilitating a media stream path **without the server between the dumb terminal and the remote terminal**, much less “transmitting, by the server, the translated abstraction of the at least one signaling message to the at least one gateway device for presentation to the remote terminal, thereby establishing the communications session and facilitating a media stream path without the server between the dumb terminal and the remote terminal,” as amended Claim 106 requires.

As another example, the cited references fail to teach or suggest “generating, by the controller, an abstraction of at least one signaling message received from the dumb terminal by interpreting an intent of the at least one signaling message, the abstraction of the at least one signaling message comprising a description of the at least one signaling message based on the interpreted intent of the at least one signaling message,” as recited by amended Claim

106. The *Office Action* concedes that *Rogers* “does not fully disclose generating, by the controller, an abstraction of at least one signaling message received from the dumb terminal.” *Office Action*, p. 3. Instead, as teaching a previous version of Claim 106, the *Office Action* contends that Figures 2A and 4 of *Amir* disclose conversion of messages from analog to digital. *Office Action*, p. 4. Even assuming for the sake of argument that *Amir* discloses conversion of messages from analog to digital (which Applicants do not concede), Applicants respectfully submit that such conversion fails to teach or suggest generating an abstraction of a signaling message that includes a **description** of the at least one signaling message **based on the interpreted intent of the at least one signaling message**, much less “generating, by the controller, an abstraction of at least one signaling message received from the dumb terminal by interpreting an intent of the at least one signaling message, the abstraction of the at least one signaling message comprising a description of the at least one signaling message based on the interpreted intent of the at least one signaling message,” as amended Claim 106 requires.

Independent Claim 113 includes limitations that, for substantially similar reasons, are not taught by the cited references. Claims 106 and 113 are thus allowable for at least these reasons. Applicants respectfully request reconsideration and allowance of Claims 106 and 113 and their respective dependent claims.

The cited references, both alone and in combination, also fail to disclose, teach, or suggest “receiving, by the server, an off-hook signal in response to a user indicating a desire to establish the communications session,” as recited by Claim 110. The *Office Action* contends that *Rogers* and *Amir* inherently disclose this limitation. *Office Action*, p. 5.

According to the M.P.E.P., “[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.” M.P.E.P. § 2112(IV) (Rev. 3, Aug. 2005) (emphasis in original) (citing *In re Rijckaert*, 9 F.3d 1531, 1534, 28 U.S.P.Q.2d 1955, 1957 (Fed. Cir. 1993)). Moreover, “[t]o establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency . . . may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *Id.* (quoting *In re Robertson*, 169 F.3d 743, 745, 49

U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999)). Furthermore, “[i]n relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Id.* (emphasis in original) (quoting *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)).

Nowhere does the *Office Action* “provide a basis in fact and/or technical reasoning” to support the assertion that receiving an off-hook signal in response to a user indicating a desire to establish the communications session “necessarily flows from the teachings of” the cited references. Thus, the burden for inherency rejections has not been met.

For at least these additional reasons, Claim 110 is allowable. Dependent Claim 117 includes elements that, for reasons substantially similar to those discussed above with respect to Claim 110, are not disclosed, taught, or suggested by the cited references. Claims 110 and 117 are thus allowable for at least these additional reasons.

Conclusions

Applicants have made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons and for other apparent reasons, Applicants respectfully request full allowance of all pending claims.

If the Examiner feels that a telephone conference or an interview would advance prosecution of this Application in any manner, please feel free to contact the undersigned attorney for Applicants.

Although no fees are believed due, the Commissioner is hereby authorized to charge any fees or credit any overpayments to **Deposit Account No. 02-0384 of Baker Botts L.L.P.**

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